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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/522,191      | 01/25/2005  | Hugh James O'Donnell | 60469-194;IT-5025   | 1477             |

26584 7590 12/14/2007  
OTIS ELEVATOR COMPANY  
INTELLECTUAL PROPERTY DEPARTMENT  
10 FARM SPRINGS  
FARMINGTON, CT 06032

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| EXAMINER |
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GRAY, JILL M

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1794

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| MAIL DATE | DELIVERY MODE |
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12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                       |  |
|------------------------------|-------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/522,191 | Applicant(s)<br>O'DONNELL, HUGH JAMES |  |
|                              | Examiner<br>Jill M. Gray      | Art Unit<br>1794                      |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 28, 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment***

2. The rejection of claims 2-4, 6, 9, and 11-12 under 35 U.S.C. 103(a) as being unpatentable over Baranda et al, US 2003/0092524 in view of PCT Patent Publication WO 01/14630A1 is withdrawn in view of applicants statement of common ownership.
3. Claims 1, 5, 7-8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Baranda et al, US 2003/009252 A1 (Baranda), for reasons of record.

Baranda discloses an elevator belt assembly comprising a plurality of cord within a jacket and a method of making, said method comprising aligning the cords in a desired alignment, tensioning the cords and applying a jacket to the cords during the tensioning process, as required by claims 1 and 7. See [0034]. The jacket is a urethane, per claims 5 and 10, and the belt has limited stretch as required by claim 8. See [0009], [0020], [0029] and [0034].

Therefore the teachings of Baranda anticipate the invention as claimed in present claims 1, 5, 7-8, and 10.

4. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Patent Publication WO 01/14630A1 (hereinafter Prewo), for reasons of record.

Prewo teaches a tension member for an elevator comprising organic fibers and steel fibers encased in a polyurethane jacket. See page 3, lines 7-14 and page 5, line 3.

Accordingly, the teachings of Prewo anticipate the invention as claimed in present claims 7-10.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 2-4, 6, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Patent Publication WO 01/14630A1 (hereinafter Prewo), for reasons of record.

Prewo teaches a tension member for an elevator comprising organic fibers and steel fibers because the combined organic and steel fibers result in a shared load that provides significantly enhanced properties. See page 3, lines 20-26. As to claims 6 and 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make an elevator belt assembly by including cords made of a synthetic material in order to obtain the efficacious properties associated therewith.

Regarding claims 2-4 and 11-12, it is the position of the examiner that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA 1955). Accordingly, it would have been obvious to the skilled artisan at the time the invention was made to determine the optimum load for tensioning the cords during

routine experimentation commensurate with the desired properties of the end product.

Therefore, the teachings of Prewo would have rendered obvious the invention as claimed in present claims 2-4, 6, 9, and 11-12.

### ***Response to Arguments***

7. Applicant's arguments filed September 28, 2007 have been fully considered but they are not persuasive.

Applicants argue that applying tension to a cord is not the same as stretching the cord and that there is nothing in Baranda that in any way indicates that any tension applied in that reference would cause the cords to be stretched, further arguing that there is nothing in Baranda that says anything about a jacket that encases the cords so that the cords remain stretched within the jacket.

In this regard, it is the examiner's position that the language of "tensioning the cords a selected amount to stretch the cords" is not specific and implies that tensioning per se results in stretching. Accordingly, the examiner has reason to believe that the tensioned cords of the prior art have some degree of stretching, even if it is in very small amounts.

Applicants argue that there is nothing in the Prewo reference that in any way suggests that the cords of that reference are stretched and there is nothing that suggests that the jacket keeps the cords stretched a desired amount without any external load applied to the belt of Prewo.

In this regard, the examiner's position is as stated above and is incorporated herein. Namely, that the language of "tensioning the cords a selected amount to stretch

the cords" is not specific and implies that tensioning per se results in stretching.

Accordingly, the examiner has reason to believe that the tensioned cords of the prior art have some degree of stretching, even if it is in very small amounts.

No claims are allowed.

### ***Conclusion***

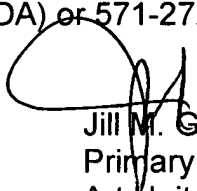
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jill M. Gray  
Primary Examiner  
Art Unit 1794

jmg